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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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02/27/2004

James Say

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01/07/2010

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EXAMINER

NATNITHADHA, NAVIN

ART UNIT

PAPER NUMBER

3735

NOTIFICATION DATE

DELIVERY MODE

01/07/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/789,776	Applicant(s) SAY ET AL.	
	Examiner NAVIN NATNITHITHADHA	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. According to the Amendment, filed 04 September 2009, the status of the claims is as follows:

Claims 2-5 and 8-39 are as originally filed;

Claims 1 and 7 are previously presented; and

Claims 6 and 40-53 are cancelled.

Response to Arguments

2. Applicant's arguments, see Remarks, p. 8, filed 04 September 2009, with respect to the rejection of claims 1-5 and 7-39 under 35 U.S.C. 103(a) as being unpatentable over Ward et al, U.S. Patent No. 5,711,861 A ("Ward"), in view of Bonnecaze et al, U.S. Patent No. 6,579,690 B1 ("Bonnecaze"), have been fully considered, but they are not persuasive.

Applicant contends, see Remarks, p. 8, the following:

Applicants note that the cited reference US Patent No. 6,579,690 ('690 Patent) issued on June 17, 2003 which is after the effective filing date of the present application of April 30, 1998. Accordingly, the '690 Patent is qualifies as a 102(e) reference under Title 35. Moreover, notwithstanding the Examiner's obviousness rejections of the pending claims under 35 USC §103(a), the appropriate section for the obviousness rejection is, 103(c)in view of the '690 Patent. Under 35 USC §103(c), a 102(e) reference that is used to establish obviousness may be disqualified if the present application and the 102(e) reference are commonly owned or subject to an obligation of assignment to a same person at the time the claimed invention was made.

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Applicants submit that the present application and the '690 Patent were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same entity at the time the claimed invention was made.

However, this argument is not persuasive. According to MPEP 2136.05,

When a prior U.S. patent, ** U.S. patent application publication>,< or international application publication* is not a statutory bar, a 35 U.S.C. 102(e) rejection can be overcome by antedating the filing date (see MPEP § 2136.03 regarding critical reference date of 35 U.S.C. 102(e) prior art) of the reference by submitting an affidavit or declaration under 37 CFR 1.131 or by submitting an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work. *In re Mathews*, 408 F.2d 1393, 161 USPQ 276 (CCPA 1969).

See also MPEP 706.02(b). Applicant did not submit an affidavit or declaration under 37 CFR 1.131 or submit an affidavit or declaration under 37 CFR 1.132 establishing that the relevant disclosure is applicant's own work in accordance with MPEP 2136.05 and 706.02(b). Thus, the rejection of claims 1-5 and 7-39 is maintained.

In addition, Applicant did not provide arguments traversing the rejection based on Ward as an obvious design choice. Thus, the rejection of claims 1-5 and 7-39 is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-5 and 7-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ward et al, U.S. Patent No. 5,711,861 A ("Ward"), in view of Bonnecaze et al, U.S. Patent No. 6,579,690 B1 ("Bonnecaze"), and in the alternative, unpatentable over Ward.

Claims 1-5 and 7-39: Ward teaches a continuous glucose monitoring system 120 (see Abstract and figs. 1-3 and 7-10A), comprising: a sensor 212 configured to detect one or more glucose levels; a transmitter 224 operatively coupled to the sensor 212, the transmitter 224 configured to receive the detected one or more glucose levels, the

transmitter 224 further configured to transmit signals corresponding to the detected one or more glucose levels; and a receiver 134 operatively coupled to the transmitter configured to receive transmitted signals corresponding to the detected one or more glucose levels, wherein the receiver 134 is operatively coupled to the transmitter 108 via an RF communication link (see col.7, ll. 41-46); wherein the transmitter is configured to transmit a current data point and at least one previous data point, said current data point and said at least one previous data point corresponding to the detected one or more glucose levels (see col. 7, ll. 41-63).

Ward does not teach “wherein the transmitter is configured to transmit three data points per minute to the receiver, said three data points corresponding to the detected one or more glucose levels” (see claim 1), and “wherein the transmitter is configured to transmit a current data point and at least one previous data point, said current data point and said at least one previous data point corresponding to the detected one or more glucose levels” (see claim 21). However, Bonnecaze teaches a continuous glucose monitoring system (see col. 5, ll. 8-58) comprising the transmitter is configured to transmit three data points per minute to the receiver, said three data points corresponding to the detected one or more glucose levels (see col. 45, ll. 42-62), and wherein the transmitter is configured to transmit a current data point and at least one previous data point, said current data point and said at least one previous data point corresponding to the detected one or more glucose levels (see col. 45, ll. 42-62). Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Wards transmitter 108 to transmit three data points per minute to

the receiver because both transmission techniques provide the same predictable results for transmission of data.

In addition, Applicant's disclosure has not disclosed that the features "wherein the transmitter is configured to transmit three data points per minute to the receiver, said three data points corresponding to the detected one or more glucose levels", and "wherein the transmitter is configured to transmit a current data point and at least one previous data point, said current data point and said at least one previous data point corresponding to the detected one or more glucose levels", provides an advantage, is used for particular purpose, or solves a stated problem. Thus, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with Ward's telemeter 108 because both transmission techniques provide the same predictable results for transmission of data.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAVIN NATNITHITHADHA whose telephone number is (571)272-4732. The examiner can normally be reached on Monday-Friday, 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles A. Marmor, II/
Supervisory Patent Examiner
Art Unit 3735

/N. N./
Patent Examiner, Art Unit 3735
01/04/2010